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In re Application of  
Marian Morys et al  
Application No. 09/882,228  
Filed: June 14, 2001  
Attorney Docket No. 007420-0067-999

In re Application of  
Marian Morys et al  
Application No. 10/713,923  
Filed: February 11, 2003  
Attorney Docket No. 007420-0116-999

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OFFICE OF PETITIONS

DECISION GRANTING  
PETITION

This is a decision on the "Petition under 37 CFR 1.53(e) and 1.181(f)" filed by facsimile on February 25, 2003, requesting that a Continued Prosecution Application (CPA) request filed on February 11, 2003, based on prior application No. 09/882,228, be treated as a continuation application under 37 CFR 1.53(b), rather than under 37 CFR 1.53(d), and be accorded a filing date of February 11, 2003. The delay in making this decision is regretted.

The petition states, in effect, that the application was inadvertently deposited as a CPA, and that the application papers that accompanied the CPA request were intended to be filed as a continuation application under 37 CFR 1.53(b). The February 11, 2003 CPA request and all accompanying papers have been located in the file of the prior application.

The request for a CPA based on prior application No. 09/882,228 was filed on February 11, 2003. However, the issue fee was paid in the prior application on November 26, 2002, and the application issued on February 11, 2003, as U.S. Patent No. 6,518,756.

Since the issue fee was paid before the CPA was filed, the CPA is improper. Also, since the prior application has issued as a patent, the CPA request cannot be processed as a proper CPA.

The CPA Request Transmittal (2 pages) was filed on February 11, 2003, while the prior application was still pending and was accompanied by a specification, drawings, an abstract page, a one page "Utility Patent Application Transmittal," and a copy of the declaration filed in the prior application. It is noted that the second page of the petition incorrectly states in bold capital letters that the specification and drawings were filed on February 24, 2003, after the prior application issued as U.S. Patent No. 6,518,756. The Office date stamp on the specification and drawings make it clear that the application papers were filed together with the CPA request on February 11, 2003, the day the prior application issued as a patent.

Petitioners state, in effect, that the application was mistakenly filed as a CPA under 37 CFR 1.53(d), when it was intended to be filed under 37 CFR 1.53(b). The present petition requests that

the application deposited as a CPA under 37 CFR 1.53(d) be treated as a continuation application filed under 37 CFR 1.53(b).

All of the continuation application papers filed on February 11, 2003 and a copy of the petition have been removed from the file of prior application No. 09/882,228 and have been assigned application No. 10/713,923. All future correspondence relating to the continuation application should be directed to this application, application No. 10/713,923.

The petition in application No. 10/713,923 is granted.

In application No. 10/713,923, the \$130.00 petition fee is being charged to deposit account No. 16-1150 as authorized in the petition.

A \$750.00 basic filing fee and a \$130.00 surcharge set forth in 37 CFR 1.16(e) is required for the application No. 10/713,923.

Applicant is given **ONE MONTH** from the date of this decision to file in application No. 10/713,923: (1) the filing fee and surcharge required above, and (2) a proper benefit claim to prior application No. 09/882,228, in order to avoid abandonment of the application. This time period may be extended pursuant to 37 CFR 1.136(a). The required benefit claim may be in the form of an amendment adding the required reference to the prior application in the first sentence of the specification following the title, or by an application data sheet. See 37 CFR 1.78(a)(2)(iii). The response, including the filing fee, surcharge, and benefit claim should be directed to the attention of Initial Patent Examination Division.

The application papers assigned application No. 10/713,923 are being forwarded to the Office of Initial Patent Examination for further processing as a continuation application filed under 37 CFR 1.53(b), not under 37 CFR 1.53(d), with a filing date of February 11, 2003, using the copy of the specification, drawings and declaration filed on that date.

Application No. 09/882,228 is being forwarded to the Files Repository.

Any inquiries related to this decision should be directed to Legal Advisor James Engel at (703) 308-5106.



Fred Silverberg  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy

JJE